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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

WILLIAM **HARRIS**,
CHRISTOPHER HUW HILL, and IAN EDWARD DAVID SMITH
(6,150,373),
Junior Party,

v.

ELLEN MYRA **DOBRUSIN**,
JAMES MARINO HAMBY, JAMES BERNARD KRAMER,
MEL CONRAD SCHROEDER, HOWARD DANIEL HOLLIS SHOWALTER,
PETER TOOGOOD, and SUSANNE A. TRUMPP-KALLMEYER
(09/623,737),
Senior Party.

Interference No. 104,798

Before SCHAFER, TORCZON, and NAGUMO, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

DECISION ON REHEARING

INTRODUCTION

The Board issued a decision on reconsideration (Paper 109) that resulted in a judgment (Paper 110) against Dobrusin for lack of a claim with written description under 35 U.S.C. 112(1). The decision on reconsideration was a significant modification of the original decision (Paper 99), which had left Harris under an order to show cause (Paper 102). Consequently, the decision on reconsideration (Paper 109) was a new decision. Cf. 37 C.F.R. § 1.658(b). Dobrusin now requests (Paper 112) reconsideration of Paper 109. Harris opposes (Paper 115).

DISCUSSION

According to Dobrusin, the decision misapprehended a critical fact when it denied Dobrusin preliminary motion 4 seeking amendment of Dobrusin claim 56. Entry of claim 56 would mean that Dobrusin would have a claim remaining in the interference and that Harris's response to the order to show cause was not sufficient.

Dobrusin notes that the basis for holding unpatentability--that a further limitation in dependent claim 56 lacked support--is not supported by the record for the amended version of claim 56, which shows the unsupported limitation in brackets, indicating that the limitation was removed. Without the further limitation, the Markush choices for R^1 and R^2 in amended claim 56 find commensurate support in original claim 1. Claims 59 and 60 stood or fell with claim 56.

Harris argues that any problem in the decision arose from Dobrusin's original failure in preliminary motion 4 to show clearly why it was entitled to entry of its amended and added claims. Instead, Harris argues that Dobrusin improperly recruited the Board to make out Dobrusin's case for it, citing Keebler Co. v. Murray Bakery Prods., 866 F.2d 1386, 1388, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989); Hillman v. Shyamala, 55 USPQ2d 1220, 1222 (BPAI 2000) (Trial Section precedent); LeVeen v. Edwards, 2002 WL 746168, *3 (BPAI) (nonprecedential); see also Stevens v. Tamai, App. No. 03-1479, slip op. at 16-17 (Fed. Cir. 4 May 2004) (reversing for failure to comply with Rule 637(f) and for reliance on Board and opposing party to plumb the administrative record).

The Keebler Co. decision involves an argument on appeal that the Trademark Trial and Appeal Board (TTAB) erred in denying motions when the basis for the error

was not presented in the supporting affidavits filed with the TTAB. The present facts are distinguishable since Dobrusin's appendices provided the relevant facts. The problem lay in the adequacy of Dobrusin's supporting argument. Similarly, Hillman involved a complete absence of proof or argument supplying a fact or justification necessary for relief. We do not understand Harris to be arguing that Dobrusin provided absolutely no basis for relief in its preliminary motion 4.

LeVeen is closer to the mark. In LeVeen, the Board characterized the movant's argument as "[o]ff the cuff and aimless rambling about a variety of subjects" and expressed frustration that "[t]here is no glue that binds or thread that ties the arguments into a meaningful presentation." 2002 WL 746168, *3. The Board, however, treated the problem as one of discretion: "The [administrative patent judge] could not have abused his discretion in connection with arguments or facts which were not presented and developed by [the movant]." Thus, the question presented is whether we abused our discretion in divining a thread of Dobrusin's justification from Dobrusin's appendices when the argument itself was deficient.

The amount of additional analysis required, including two decisions on reconsideration with attendant briefing, suggests that exercising discretion to address the merits in the first instance may have been ill-advised. Moreover, we agree with Harris (Paper 115 at 5) that the development of Dobrusin's argument on amended claim 56, particularly in Dobrusin preliminary motion 4, was deficient. We did, however, address the merits and now that the facts have been developed, there does not seem to be any argument on the merits that the two aspects of claim 56 that had been held to

be unsupported are in fact supported. Consequently, having already elucidated the necessary facts, the only remaining question is whether the Board's acting on these facts prejudices Harris unduly. The fact that Harris may lose is not, in itself, an undue prejudice.

In our last reconsideration, we noted that Dobrusin's motion could have been more helpful, but that Harris had not shown prejudice sufficient for us to ignore a clear error in our decision that arose sua sponte (Paper 109 at 16). Harris has not shown much in the way of prejudice with respect to this second error either. When, as here, the error is clear we can reasonably exercise discretion to address and cure the error.

DECISION

Upon consideration of Dobrusin's request for rehearing (Paper 112) and Harris's opposition (Paper 115), it is:

DECIDED that the request for rehearing be GRANTED;

FURTHER DECIDED that Dobrusin preliminary motion 4 be GRANTED with respect to amended claims 56, 59 and 60;

FURTHER DECIDED that the judgment in Paper 110 be WITHDRAWN, except that Dobrusin's preliminary statement has been and remains returned unopened; and

FURTHER DECIDED that a copy of this decision be entered in the administrative record of Harris's 6,150,373 patent and of Dobrusin's 09/623,737 patent application.

RICHARD E. SCHAFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

MARK NAGUMO
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

INTERFERENCE TRIAL SECTION

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